REMARKS:

Claims 23-42 are presented for examination, with new claims 23-42 having been added and claims 1, 2, 4, and 16-22 having been cancelled, without prejudice or disclaimer.

The present invention, as recited in independent claims 23, 28, 33 and 38, relates to a computer implemented method for identifying patents in a database. Under the claimed method, once the enumerated searching, operating and displaying steps begin, each of the searching, operating and displaying steps is carried out without additional patent identification input from the user.

Of note, the difference between independent claims 23 and 28 resides in steps (c) and (d), such that in claim 23 a patent identified in the second generation data that is cited in the patent under test is filtered out and not displayed, while in claim 28 a patent identified in the second generation data that is cited in the patent under test is displayed as such.

Further, it is noted that independent claim 33 is similar to independent claim 23, with the difference being that in claim 33 the second generation data identifies data corresponding to at least one patent in the database which cites at least one patent identified by the first generation data (as opposed to being cited in).

Likewise, it is noted that independent claim 38 is similar to independent claim 28, with the difference being that in claim 38 the second generation data identifies data corresponding to at least one patent in the database which cites at least one patent identified by the first generation data (as opposed to being cited in).

In any case, it is respectfully submitted that the invention recited by these independent claims 23, 28, 33 and 38 (as well, of course, as the claims depending therefrom) is neither shown nor suggested by any of the cited documents.

More particularly, reference will now be made to the Examiner's comments and hypothetical example accompanying the January 5, 2004 Advisory Action. As best understood, the Examiner's position is that Rivette et al. '767 discloses: (a) a "backward" citation report which operates to identify, for a source patent, the patents which were cited during the prosecution of the source patent; and (b) a "forward" citation report which operates to identify, for a source patent, the patents in which the source patent was cited.

While the applicant agrees with the Examiner that Rivette et al. '767 discloses such "backward" and "forward" citation reports (*see*, e.g., Col. 87 line 5 to Col. 89 line 53 as well as Figs. 61-65, 86 and

87), it is respectfully submitted that Rivette et al. '767 nowhere shows or suggests the claimed method, wherein, once the enumerated searching, operating and displaying steps begin, each of the enumerated searching, operating and displaying steps is carried out <u>without additional patent identification input from the user.</u>

That is, in order to attempt to emulate the technique of the present invention, a user of the Rivette et al. '767 system would need, at the very least, to: (a) input an identity of the source patent (i.e., patent #1 in the Examiner's example) for a citation report to obtain the first generation data (i.e., patent #2 in the Examiner's example) and second generation data (i.e., patent #5 through #8 in the Examiner's example); and (b) manually command a second citation report on one of the second generation data by providing additional patent identification input to "reset" the source patent for the second citation report to another patent (e.g., patent #5 in the Examiner's example).

Further, to the extent that the user wished to obtain more compete coverage (e.g., of the type recited in claims 26, 31, 36 and 41, for example), the user would need to: (a) manually command a third citation report on a second one of the second generation data by providing additional patent identification input to "reset" the source patent for the third citation report yet again (e.g., to patent #6); (d) manually command a fourth citation report on a third one of the second generation data by providing additional patent identification input to "reset" the source patent for the fourth citation report yet again (e.g., to patent #7); and (e) manually command a fifth citation report on a fourth one of the second generation data by providing additional patent identification input to "reset" the source patent for the fifth citation report yet again (e.g., to patent #8).

Such repeated manual patent identification (even, in this example, in the simple case of only resetting the source patent to patent #5) <u>is clearly distinct</u> from the claimed feature relating to carrying out the steps <u>without additional patent identification input from the user.</u>

Moreover, it is respectfully submitted that any assertion to the effect that it would somehow have been obvious to cause the Rivette et al. '767 system to carry out the aforementioned citation reporting automatically, in a manner similar to that currently claimed, would be <u>utilizing impermissible hindsight</u> regarding the teachings of the present invention. The applicant submits that Rivette et al. '767 simply does not contemplate use of the "backward" and "forward" citation reports to perform as presently claimed (for example, even under the Examiner's theory (which presumably is giving the broadest possible interpretation to Rivette et al. '767), a user of the Rivette et al. '767 system needs to manually

"reset" each of patents #5 through #8 as a new "source" patent for each of the second generation data citation reports). In this regard, it is respectfully noted that the Rivette et al. '767 disclosure is particularly large (including 142 columns of text and 186 figures). Thus, had Rivet et al. contemplated carrying out the aforementioned citation reporting in the manner taught by the present invention, they would have had more than ample opportunity to indicate so.

Moreover, it is noted that in each of independent claims 23 and 33 (as well, of course, as the claims depending therefrom) the data is displayed such that the display does not include any patents filtered out (i.e., such filtered out patent(s) being one or more patents cited in the patent under test).

Again, it is respectfully submitted that Rivet et al. '767 nowhere shows or suggests this claimed feature (in fact, the "Patent Citation Module" discussion found in Rivet et al. '767 at Col. 87 line 5 to Col. 89 line 53 appears to point to the display of all patents found during the production of the patent citation report).

Finally, applicant respectfully notes that this Amendment is fully supported by the originally filed application and thus, no new matter has been added. For this reason, the Amendment should be entered.

More particularly, support for new claims 23, 28, 33 and 38 is found in claims 1-5 as filed; page 17, line 30 to page 21, line 23; Figs. 2, 3 and 5-10, as filed; and throughout the specification.

Further, support for new claims 24, 29, 34 and 39 is found in page 45, lines 1-5; and throughout the specification.

Further still, support for new claims 25, 30, 35 and 40 is found in claim 4, as filed; page 18, lines 12-14; and throughout the specification.

Further still, support for new claims 26, 31, 36 and 41 is found in page 17, line 30 to page 21, line 23; and throughout the specification

Further still, support for new claims 27, 32, 37 and 42 is found in page 29, line 28 to page 31, line 5; Figs. 7 and 9, as filed; and throughout the specification.

In conclusion, it is respectfully submitted that all of the pending claims are now in condition for allowance.

Favorable reconsideration is earnestly solicited.

Respectfully submitted,

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I hereby certify that this correspondence is being deposited this date with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Matthew B. Tropper   2/23/04
Reg. No. 37,457   Date